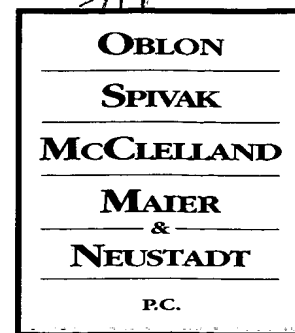




Docket No.: 231191US26

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

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RE: Application Serial No.: 10/698,415
Applicants: Aline ABERGEL
Filing Date: November 3, 2003
For: PACKAGING A PRODUCT AND PACKAGING
METHOD
Group Art Unit: 3721
Examiner: GLORIA R. WEEKS

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
APPEAL BRIEF**

Our credit card payment form in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 231191US26

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ALINE ABERGEL : EXAMINER: WEEKS, GLORIA R.
SERIAL NO: 10/698,415 :
FILED: NOVEMBER 3, 2003 : GROUP ART UNIT: 3721
FOR: PACKAGING A PRODUCT AND :
PACKAGING METHOD :

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

I. Real Party In Interest

The real party in interest for this Appeal in the present application is L'Oreal, by way of assignment recorded in the U.S. Patent and Trademark Office at reel 015181, frame 0032.

II. Related Appeals and Interferences

To the best of Appellant's knowledge there are no other appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

III. Status of Claims

Claims 1-16, 18 and 25-33 are pending in this application. Claims 1-16, 18 and 29-33 were rejected in the Final Rejection. Claims 25-28 were withdrawn from consideration.

IV. Status of Amendments

An Amendment After Final Rejection was filed on August 31, 2005 amending Claims 16 and 31 and canceling Claim 33. The Amendment After Final Rejection was not entered by the Examiner because the Examiner stated that the amendments raised new issues that would require further consideration and/or search and they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

V. Summary of Claimed Subject Matter

The claimed invention relates to a device to package a product. The device includes a support having two faces, at least one cavity passing at least partially through the support. The cavity opens on a first face of the two faces through a first opening. The cavity contains a product. A lid is articulated to the support.

In accordance with one of the features of the invention, Appellant has recognized an advantageous arrangement where a sticker forming a mirror is adhesively bonded onto one of the faces of the lid and one of the faces of the support to provide the articulation. This arrangement is included in independent Claim 1. By way of example, as shown in Figs. 4 and 5, support 20 has faces 22 and 23. Lid 30 has faces 31 and 32. Cavity 21 opens on a first face 22 of the support 20. A lid 30 is articulated to the support 20 by a sticker forming a mirror 70 that is bonded onto face 31 of the lid and face 22 of the support. See, e.g. specification at page 7, paragraph [0045].

In accordance with another feature of the invention, Appellant has recognized an advantageous arrangement where the cavity opens on the second face of the support through a second opening. An adhesive sheet is fixed onto one face of the lid and onto one face of the

support and closes off the second opening. This arrangement is included in independent Claim 16.

By way of further example, as shown in Fig. 1, support 20 has faces 22 and 23. Lid 30 has faces 31 and 32. Cavity 21 opens on first face 22 through first opening 210. Cavity 21 opens on second face 23 through second opening 211. The cavity 21 contains a product 10 with a first side adjacent the first opening 210 and a second side adjacent the second opening 211. The lid 30 is articulated to the support 20 by an adhesive sheet 50 fixed onto face 32 of the lid and face 23 of the support. The adhesive sheet 50 closes off the second opening 211. The portion of the adhesive sheet 50 which covers the second opening 211 faces the second side of the product 10. See e.g. specification at page 5, paragraphs [0031] to [0037].

Claim 33 further recites that prior to a first use, the adhesive sheet 50 is in contact with the product 10 at the second opening 211. See e.g. specification at page 6, paragraph [0035].

With these arrangements, a compact device is provided which mimics a make-up case and is simple and inexpensive to produce.

VI. Rejections To Be Reviewed On Appeal

(1) The first rejection to be reviewed on appeal is of Claims 1-6, 8, 9 and 11-14 which stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. publication No. 2004/0003825 to Kelly in view of USP 4,491,389 to Coburn, Jr. (Appellant notes that Claims 4, 5 and 6 depend from Claim 16. Claim 16 is rejected under 35 U.S.C. § 103(a) over Kelly in view of WO 97/15910 to Guiard. Thus Appellant believes that the rejection of Claims 4, 5 and 6 over Kelly and Coburn, Jr. is an error.)

(2) The second rejection to be reviewed on appeal is of Claims 10 and 15 under 35 U.S.C. § 103(a) over Kelly in view of Coburn as applied to Claims 1 and 14 and further in view of Guiard. Claims 10 and 15 depend from independent Claim 1.

(3) The third rejection to be reviewed on appeal is of Claims 7, 16, 18 and 33 which stand rejected under 35 U.S.C. § 103(a) as being obvious over Kelly in view of Guiard. Claims 7, 18 and 33 all depend from independent Claim 16.

(4) The fourth rejection to be reviewed on appeal is of Claims 29-32 which stand rejected under 35 U.S.C. § 103(a) as being obvious over Kelly in view of Guiard and further in view of Coburn. Claims 29-32 depend from Claim 16.

VII. Grouping of Claims

Each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282. For purposes of this appeal, the claims are grouped as follows:

Group I, Claims 1-3, and 8-15

Group II, Claims 16, 4-7, 18, and 29-32

Group III, Claim 33.

Each of the Groups I-III will be argued separately in the following arguments. The groups do not stand or fall together.

VIII. Argument

A. Group I

Respectfully, it is submitted that the Office Action presents two inconsistent positions with respect to the rejection of Claim 1, and it is submitted that neither position establishes the present invention is disclosed or rendered obvious by the cited references. Specifically, in

the rejection of Claim 1 based on Kelly and Coburn, the Office Action acknowledges (at page 3) that Kelly does not disclose the sticker forming a mirror, and therefore, the Office Action asserts that it would have been obvious to have modified Kelly in view of the teachings of Coburn to provide the claimed mirror. However, the Office Action then asserts (at page 7) that Kelly is considered to disclose a metallic foil which the Examiner considered to be a mirror – apparently asserting that Coburn is not relied upon for a mirror, but instead that a mirror is inherent in Kelly. It is respectfully submitted that neither of the positions asserted in the Office Action establish that the cited references anticipate or render obvious the present invention.

Considering Kelly alone, it is submitted that the disclosure of a metallic material does not inherently mean that the material is a mirror as the Office Action (at p. 7) asserts. As set forth in MPEP 2112 (emphasis added): “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may *not* be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (quoting *In re Robertson*, 169 F.3d743, 745 (Fed. Cir. 1999)).

A metallic material is clearly not inherently a mirror as numerous metallic materials do not inherently provide a mirror. Moreover, considering the entirety of the Kelly disclosure, it is clear the reference to a metallic material does not provide a disclosure as to the use of a mirror, because when Kelly desires to specify a mirror, Kelly plainly states that a mirror is provided – at element 22.

Although the Office Action (at page 7) states that Kelly discloses the use of a metallic foil, at paragraph 0021 Kelly merely discloses the use of a metallic material as an alternative to a cardboard material for the hinge 24. The specification of a metallic material or even a

foil alternative is clearly not a disclosure that a mirror is provided. Further, the Examiner's assertion that it is well known that metallic foils can act as a mirror is insufficient, the Examiner has provided no evidence to establish that one skilled in the art would have modified Kelly to provide a mirror with the hinge 24. The teachings of Kelly are to the contrary, a cardboard material is preferred (clearly not a mirror), and a metal material is merely mentioned among a list of alternatives – with no mention at all that the metal material or any other alternative forms a mirror.

Kelly in fact discloses a mirror 22 in the lid of the device. Paragraph 0019 and Fig. 1 of Kelly. The apparent assertion of the Office Action that Kelly's metal material alternative (listed among many other alternatives to a cardboard hinge, including a cellulose based material or polymeric material) inherently would be a mirror is incorrect. Kelly already provides a mirror at 22. The specific disclosure of a mirror in the lid further demonstrates that the general disclosure of a metallic material as alternative material for the hinge clearly does not provide a disclosure as to the use of a mirror associated with a hinge.

None of the cited references discloses or suggests the combined features set forth in Claim 1 in which a support and a lid are articulated to each other by a sticker which forms a mirror.

The combination of Kelly with Coburn also fails to render obvious the combined features set forth in Claim 1. Specifically, Coburn merely teaches the use of a metallized surface 30 which provides a reflecting surface of a mirror as shown at 12 in Fig. 1 (col. 2, line 64). At best, if one were to modify the teachings of Kelly in view of the teachings of Coburn, one would simply substitute the mirror 22 in the lid of Kelly with a mirror formed with a surface as disclosed by Coburn. However, there is nothing whatsoever to suggest to provide a sticker which both provides an articulation between a support and a lid, and which forms a mirror.

In view of the forgoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or render obvious the combined feature set forth in Claim 1.

With regard to dependent Claim 10, the Office Action asserts that Claim 10 is obvious in view of the combined teachings of Kelly, Coburn and Guiard. However, Guiard provides a cover because there is no lid, and it is only Applicant's own disclosure which suggests the combined features of Claim 10 in combination with features of Claim 1 (from which Claim 10 depends).

In addition to the forgoing, the Office Action asserts that the dimensions of the 0.5mm-2mm are a matter of "optimal or workable ranges" and asserts such feature would have been obvious, without the citation of any evidence in support. This rejection is traversed in that: (1) the Office Action fails to establish how the dimensions are a mere matter of optimal or workable ranges; (2) particularly with regard to this feature, the Office Action improperly considers features in isolation rather than considering the claimed subject matter as a whole (including not only the subject matter of dependent Claims 11 and 12, but also the claims from which they depend). In this regard, Appellant has recognized that the present invention is particularly advantageous for a small-sized product, for example, one that can be provided as a sample, because the present invention is particularly advantageous in the context of a small-sized sample-like device that must be efficiently formed with a compact size. The cited references also fail to disclose or suggest the features set forth in dependent Claims 11 and 12 – particularly in combination with the features of the claims from which they depend.

B. Group II

Neither Kelly nor Guiard disclose a cavity containing a make-up product having a first side adjacent a first opening and a second side adjacent a second opening. Instead, Kelly discloses a product 12 located in cavity 14a. In Kelly, the product 12 is held in a cosmetic pan 12a. See Figure 3 and paragraph [0027]. Thus, the product 12 is not adjacent a first and second opening. In Guiard, product 20 is held in tray 18 which is placed in recess 16. See Abstract and Figure 2. Thus, material 20 is not adjacent a first opening and a second opening, as in Claim 16.

Neither Kelly nor Guiard disclose a support and a lid articulated to each other by an arrangement comprising an adhesive sheet fixed onto one face of a lid and onto one face of a support wherein the adhesive sheet closes off the second opening of the cavity with a portion of the adhesive sheet which covers the second opening directly facing the second surface of the product contained in the cavity. Instead, Kelly discloses a cloth material 20 which is positioned on the base 14 and lid 16 to cover the exposed surfaces of the cosmetic case 10. The cloth material 20 is secured to the base and the lid 16 through adhesive bonding. See Kelly at paragraph [0018]. The base 14, lid 16 and first hinge 24 are constructed of a material, such as cardboard. Thus, the hinges of Kelly are formed by a cardboard material which is covered with a cloth that is fixed through adhesive bonding. No portion of the cloth or cardboard material closes off a cavity containing the cosmetic material 12. See e.g., Figure 3.

Guiard merely discloses a means 22 for attaching tray 18 to the holder. The means 22 does not cover the second opening directly facing the second side of the product contained in the cavity. Nor does the means 22 provide an articulation of the lid to the support. The May 16, 2005 Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kelly to include the cavity of Guiard for the purpose

of providing the capability to insert and remove a tray of cosmetic products from the cavity. However, this ignores the disclosure of Kelly at paragraph 27 which includes pan 12a. The Office Action further asserts that Guiard further discloses providing an adhesive sheet directly over the second opening of the cavity. This assertion is respectfully traversed. As discussed above, means 22 covers the tray 18 and not the material 20.

The Office Action also fails to establish how, absent Appellant's own disclosure, one skilled in the art would provide an arrangement as set forth in Claims 29 and 30 arranged as set forth in the claims. The Office Action appears to merely reconstruct the claimed invention by selectively picking and choosing elements from the various references and arranging them as set forth in the claims, based only upon the subject matter set forth in the claims and absent any teachings to arrange elements as only described in the present specification.

In addition to the forgoing, Appellant asserts the arguments previously made with respect to Claims 11 and 12 applied to Claims 28 and 32.

C. Group III

Claim 33 recites the feature in which a lid and support are articulated to each other by an arrangement which includes an adhesive sheet, and that the adhesive sheet also covers the opening extending through the support, with the adhesive sheet directly contacting the make-up product in the cavity of the support. None of the cited references discloses or suggests an arrangement as set forth in Claim 33, in which an adhesive sheet provides both an articulation between a lid and a support and also which closes off an opening in a support such that the adhesive sheet contacts the product as set forth in Claim 33.

The Office Action acknowledges that Kelly does not even disclose an arrangement in which a cavity is provided having first and second openings. To overcome such deficiencies,

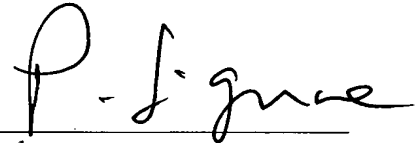
the Office Action relies upon the teachings of Guiard. However, Guiard merely discloses providing a cover to close an opening. There is no disclosure or suggestion in the references, considered individually or collectively, as to the provision of an adhesive sheet which both provides an articulation between a lid and a support, and which covers an opening of a make-up product containing cavity of a support with the adhesive sheet in contact with the product. Accordingly, it is submitted that even considering the combined teachings of the cited references, the invention set forth in Claim 33 would not result.

XII. Conclusion

In view of the above remarks, Appellant respectfully request the rejections of the Office Action dated May 16, 2005 be **REVERSED**.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1. A device for packaging a product comprising:

a support having a flat overall shape and having two faces, said support further including at least one cavity that passes at least partially through said support and which opens on a first face of said two faces through a first opening, and wherein said cavity contains a product;

a lid having a flat overall shape, and wherein said lid is articulated to the support; and wherein the support and the lid are articulated to each other by an arrangement comprising a sticker forming a mirror adhesively bonded onto one of the faces of the lid and onto one of the faces of the support.

Claim 2. A device according to claim 1, wherein the lid can rest on the support so as to at least partly cover the first face of the support in which the first opening opens.

Claim 3. A device according to claim 2, wherein the lid can cover all of the first face of the support.

Claim 4. A device according to claim 16, wherein said adhesive sheet is formed by at least one layer of a thermoplastic material.

Claim 5. A device according to claim 4, wherein said at least one layer of thermoplastic material includes at least one material selected from the group consisting of polyolefins and polyesters.

Claim 6. A device according to claim 4, wherein said adhesive sheet includes aluminum.

Claim 7. A device according to claim 16, wherein printed matter is provided on said adhesive sheet.

Claim 8. A device according to claim 1, wherein the sticker is formed by at least one layer comprising at least one thermoplastic material and a layer of paint forming a mirror.

Claim 9. A device according to claim 8, wherein said at least one thermoplastic material includes at least one of a polyolefin and a polyester.

Claim 10. A device according to claim 1, further including a removable cover removably closing off the first opening and wherein said removable cover is removed prior to use in order to access the product.

Claim 11. A device as recited in claim 1, wherein at least one of said support and said lid has a thickness in a range of 0.5 to 2.0 mm.

Claim 12. A device as recited in claim 1, wherein each of said lid and said support has a thickness in a range of 0.5 to 2.0 mm.

Claim 13. A device as recited in claim 1, wherein said product disposed in said cavity is a make-up product.

Claim 14. A device as recited in claim 1, wherein said device contains a cosmetic sample in said cavity.

Claim 15. A device as recited in claim 14, wherein said cavity has a circular cross-section.

Claim 16. A device for packaging a make-up product comprising:
a support having two faces, said support further including at least one cavity that passes at least partially through said support and which opens on a first face of said two faces through a first opening, wherein the cavity opens on a second side of said two faces through a second opening, and wherein said cavity contains a make-up product having first side adjacent said first opening and a second side adjacent said second opening;

a lid, wherein said lid is articulated to the support; and

wherein the support and the lid are articulated to each other by an arrangement comprising

an adhesive sheet fixed onto one face of the lid and onto one of the faces of the support, wherein the adhesive sheet closes off said second opening of the cavity with a portion of said adhesive sheet which covers said second opening directly facing said second surface of said make-up product contained in said cavity.

Claim 18. A device according to claim 16, the device further including a cover removably attached to said first face, and wherein said cover extends over and covers said first opening to cover the make-up product in said cavity, and wherein when said device is in a closed position said lid at least partially covers said first face of said support and said lid also covers said cover of said first opening.

Claim 29. A device as recited in claim 16, further including a sticker forming a mirror adhesive bonded to one of the faces of said lid.

Claim 30. A device as recited in claim 29, further including a removable cover which covers said first opening, and wherein when said lid and said support are in a closed position, said removable cover is between said support and said mirror.

Claim 31. A device according to claim 30, wherein prior to a first use said removable cover and said adhesive sheet are in contact with said make-up product contained in said cavity.

Claim 32. A device according to claim 31, wherein said support has a thickness in a range of 0.5 to 2.0 mm, and wherein said lid has a thickness in a range of 0.5 to 2.0 mm.

Claim 33. A device according to claim 16, wherein prior to a first use said adhesive sheet is in contact with said make-up product at said second opening.

EVIDENCE APPENDIX

None.

RELATED PRECEDING APPENDIX

None.



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IN RE APPLICATION OF :
ALINE ABERGEL : EXAMINER: WEEKS, GLORIA R.
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PACKAGING METHOD :

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Notification of Non-Compliant Appeal Brief mailed January 20, 2006, Applicants hereby attach a revised Appeal Brief including references to the specification by page and paragraph with respect to structure and material corresponding to independent Claims 1, 16 and 33.

Thus, Applicant believes that the Appeal Brief is now compliant, and respectfully requests the rejections of the Office Action dated May 16, 2005 be REVERSED.

Respectfully submitted,

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